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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/650,537 | 08/28/2003 | Gregory G. Kuelbs | 0638MH-40982-US | 9033 |

38441 7590 08/11/2004

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| EXAMINER | |
|---|---|
| SAWHNEY, HARGOBIND S | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2875 | |

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/650,537 | KUELBS, GREGORY G. | |
| | Examiner | Art Unit | |
| | Hargobind S Sawhney | 2875 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on *28 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/28/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 16-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 10-14 of prior U.S. Patent No. 6,612,713 B1. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1,5-13 and 15 are rejected under the judicially created doctrine of double patenting over claims 1-9 of U. S. Patent No. 6,612,713 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Subject matter claimed in the instant application is disclosed and covered in the U.S. Patent No. 6,612,713 B1, since U.S. Patent No. 6,612,713 B1 and the instant application are basically claiming common subject matter as follows:

| Instant Application 10/650,537 | Reference: U.S. Patent No. 6,612,713 B1 ('713), | Discussion on differences and additional References |
|---|---|---|
| Claims 1 and 6-9 | Claims 2-5 | Substantially identical; Claim 2, lines 1-14, of ('713 B1) meets the limitations of Claim 1 of the instant application.<br>Claim 2, lines 15-17 of ('713 B1) meets the limitations of Claim 6 of the instant application.<br>Claims 3-5 of ('713 B1) meet respective limitations of claims 7-9 of the instant application. |

| Instant Application 10/650,537 | Reference: U.S. Patent No. 6,612,713 B1 ('713), | Discussion on differences and additional References |
|---|---|---|
| Claims 10-12 | Claims 6-8 | Substantially identical; Claim 6, lines 15-19 of ('713 B1) meets the limitations of Claim 10 of the instant application. Further, claims 7 and 8 of ('713 B1) meet the limitations of respective claims 11 and 12 of the instant application. |
| Claims 13 and 15 | Claim 9 | Substantially identical; entire Claim 9 of ('713 B1) meets the limitations of dependent claims 13 and 15 of the instant application. |

It would be have been obvious to one of ordinary skill in the art at the time of the invention to meet the limitations of claims 1,5-13 and 15 with the teaching recited in claim 2-9 of U.S. Patent No. 6,612,713 B1.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 2 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 6,612,713 B1 in view of Winterer (US Patent No.; 5,664,874).

Claim 1, lines 5-8, of ('713 B1) substantially meets the limitations of claims 2 and 4 of the instant application. However, Claim 1 of the instant application does not specifically claim:

- the rechargeable electrical power system being powered by at least one rechargeable battery; and
- the rechargeable power system (rechargeable battery) being carried together within the housing of the solar power system.

On the other hand, Winterer ('874) discloses a warning light 10 (Figures 7 and 8) comprising:

- a rechargeable electrical power system including rechargeable batteries 145,146 (Figures 3,7 and 8, column 6, lines 65-67; column 7, lines 1 and 2); and
- both the rechargeable batteries and the solar system being held in the same housing (Figures 7 and 8).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of (' 713) by providing rechargeable batteries and housing together with the power system in the same housing as taught by Winterer ('874) for the benefits of cost saving resulting from reduction of parts.

6. Claims 3 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 9 of U.S. Patent No. 6,612,713 B1 in view of Molnar, IV (US Patent No.: 6,298,866 B1).

Claim 9, lines 5-8, of ('713 B1) substantially meets the limitations – rechargeable electrical power system and a solar power system- of Claim 3 of the instant application. However, Claim 9 of the instant application does not specifically claim:

- the rechargeable power system (rechargeable battery) being carried by the base support portion.

On the other hand, Molnar, IV ('866 B1) discloses an umbrella apparatus 10 (Figure 1) comprising a battery power supply 36 being carried by the base portion of the apparatus (Figure 1, column 3, lines 17 and 18.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of (' 713) by providing positioning the battery power supply at the base of the apparatus as taught by Molnar, IV ('866 B1) for the benefits of easy access to the batteries for their replacement, and less wiring for conventional electrical power supply needed for recharging the batteries..

Further, regarding Claim 14, Claim 9, lines 15-28 of ('713 B1) substantially meets the limitations – a cooling system carried by the canopy , and conductively coupled to the rechargeable electrical power system- of Claim 13 of the instant application. However, Claim 9 of the instant application does not specifically

claim the cooling system including at least one fan conductively coupled to the rechargeable electrical power system.

On the other hand, Molnar, IV ('866 B1) discloses an umbrella apparatus 10 (Figure 1) comprising a cooling system including a fan 18 (Figure 1, column 3, lines 1 and 2) conductively coupled to a power system.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of (' 713) by providing the fan as taught by Molnar, IV ('866 B1) for the benefits of efficient air circulation and cooling system.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is on 571-272-2380. The examiner can normally be reached on 6:15 - 2:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications and 703-872-9319.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number 703-308-2956.

HSS

8/5/2004

THOMAS M. SEMBER
PRIMARY EXAMINER